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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,537	03/17/2006	Karl-Heinrich Herber	056310.57444US	2766
23911 7590 06/10/2009 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300				
EXAMINER				
THEODORE, MAGALI P				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,537

Applicant(s)

HERBER, KARL-HEINRICH

Examiner

Magali P. Théodore

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-11 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-11, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Applicant's amendment filed February 20, 2009 was received.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being Liebscher et al. by (US 4,003,145), henceforth Liebscher.

Regarding **claim 7**, Liebscher discloses a method of making shoes by placing an edge of an inner sole on the edge of a casting mold, placing an edge of a shoe upper piece (fig 4 part 1) in the mold and inside the an inner side of the inner sole (fig 4 part 15), and pressing the two together (col 2 ln 15-21).

Regarding **claim 10**, Liebscher teaches aligning inner surfaces of the upper piece and inner sole (fig 4).

Regarding **claim 11**, Liebscher teaches sewing together the upper piece and inner sole (col 1 ln 39-40).

Claim Rejections - 35 USC § 103

Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartneck (US 4,333,193) in view of Liebscher.

Regarding **claim 4**, Bartneck discloses a method making a shoe within a casting mold with an upper edge (fig 3 parts 30, 32), the shoe made of an upper piece (fig 3

part 2) which is formed of an upper and an inner sole (fig 3 part 14) fastened to it, the upper piece bonded to the sole in an assembled shoe, by inserting a fillet (fig 3 part 6) into the upper, filling the casting mold with a shoe base material (col 2 ln 31-32), placing the edge of the upper piece on the casting mold edge from above (col 2 ln 29-30, 33-35), placing a pressing frame (fig 3 part 24) on the upper piece edge and thus on the casting mold edge, wherein only the upper piece edge rests on the casting mold edge and wherein the upper is fixed internally to the inner sole such that the shoe base material presses the inner sole against an edge of the upper that is adjacent to the fillet (col 2 ln 36-38).

Bartneck does not teach placing an edge of the inner sole on the casting mold edge. Bartneck's method inverts the roles of the upper piece and the inner sole. However, whether to display the inner sole or the upper piece on the exterior of the finished shoe is a matter of design choice based on aesthetic preferences. Bartneck's treating the edge of the upper piece as decorative is evidence by his use of non-functional stitching (fig 2 part 8) along that edge in addition to the functional seam (fig 2 part 4). Liebscher teaches having edge of an inner sole (fig 4 part 15) extend over the outer sole (fig 4 part 4) in order to visually aggrandize the sole for aesthetic reasons (col 1 ln 10-12). Therefore, it would have been obvious to one of ordinary skill in the art to use the exposed edge of inner sole as the "mold engaging lip" (col 3 ln 3) and place it on the casting mold edge taught by Bartneck because Liebscher teaches having an inner sole extend over the outer sole to the total sole look bigger.

Regarding **claim 5**, Bartneck teaches that upper piece and inner sole are connected by a seam (fig 2 part 4).

Claim 6 recites that the upper piece is the strap of a sandal. This limitation defines the type of *product* being made; it does not change or affect the steps that constitute the *method*. Therefore, this recitation does not impart patentable distinction to the method being claimed. In any case, it would have been obvious to one of ordinary skill in the art to replace the brogue upper piece (fig 1 part 2) with an upper corresponding to a sandal, an athletic shoe or a espadrille because there is a market for these and many other types of shoes.

Regarding **claim 7**, Bartneck discloses a method making a shoe by placing an edge of an upper piece (fig 3 part 10) on the edge (fig 3 parts 30, 32) of a casting mold, placing an edge of the shoe's inner sole (fig 3 part 14) in the mold and inside an inner edge of the upper piece, and pressing these two together (col 2 ln 33-36).

Bartneck does not teach placing an edge of the inner sole on the casting mold edge. Bartneck's method inverts the roles of the upper piece and the inner sole. However, whether to display the inner sole or the upper piece on the exterior of the finished shoe is a matter of design choice based on aesthetic preferences. Bartneck's treating the edge of the upper piece as decorative is evidence by his use of non-functional stitching (fig 2 part 8) along that edge in addition to the functional seam (fig 2 part 4). Liebscher teaches having edge of an inner sole (fig 4 part 15) extend over the outer sole (fig 4 part 4) in order to visually aggrandize the sole for aesthetic reasons (col 1 ln 10-12). Therefore, it would have been obvious to one of ordinary skill in the art to

use the exposed edge of inner sole as the "mold engaging lip" (col 3 ln 3) and place it on the casting mold edge taught by Bartneck because Liebscher teaches having an inner sole extend over the outer sole to the total sole look bigger.

Regarding **claim 8**, Bartneck teaches that the pressing step includes expanding a shoe base material (col 2 ln 33-39).

Regarding **claim 9**, Bartneck teaches that the pressing step forms an indentation on the inner side of the inner sole (fig 3 part 14).

Regarding **claim 10**, Bartneck teaches aligning inner surfaces of the upper piece and inner sole (fig 3 parts 2, 14).

Regarding **claim 11**, Bartneck teaches sewing together the upper piece and inner sole (col 2 ln 22).

Regarding **claim 16**, Bartneck discloses a method making a shoe by placing an edge of an upper piece (fig 3 part 10) on the edge (fig 3 parts 30, 32) of a casting mold, placing an edge of the shoe's inner sole (fig 3 part 14) in the mold and inside an inner edge of the upper piece, and pressing these two together (col 2 ln 33-36) such that the upper is fixed internally to the inner sole such that the shoe base material presses the inner sole against an edge of the upper that is adjacent to the fillet (col 2 ln 36-38). Bartneck teaches that the pressing step includes expanding a shoe base material (col 2 ln 33-39).

Bartneck does not teach placing an edge of the inner sole on the casting mold edge. Bartneck's method inverts the roles of the upper piece and the inner sole. However, whether to display the inner sole or the upper piece on the exterior of the

finished shoe is a matter of design choice based on aesthetic preferences. Bartneck's treating the edge of the upper piece as decorative is evidence by his use of non-functional stitching (fig 2 part 8) along that edge in addition to the functional seam (fig 2 part 4). Liebscher teaches having edge of an inner sole (fig 4 part 15) extend over the outer sole (fig 4 part 4) in order to visually aggrandize the sole for aesthetic reasons (col 1 In 10-12). Therefore, it would have been obvious to one of ordinary skill in the art to use the exposed edge of inner sole as the "mold engaging lip" (col 3 In 3) and place it on the casting mold edge taught by Bartneck because Liebscher teaches having an inner sole extend over the outer sole to the total sole look bigger.

Response to Arguments

Applicant's arguments filed February 20, 2009 have been fully considered but they are not persuasive.

Applicant argues that Liebscher places not an inner sole but a welt on the edge of the casting mold. In response to Applicant's argument, Liebscher's part 15 is structurally indistinguishable from Applicant's inner sole as claimed. In order to distinguish them, Applicant would need to claim either a structural feature or a material that is different.

Applicant argues that because there is a step of placing Liebscher's part 15 on the last, Liebscher does not teach pressing the upper into the insole. In response to Applicant's argument, since the upper and the insole are in place when the mold is

closed, they are subject to pressure and pressed into each other when the mold is clamped.

Applicant argues that Bartneck's upper is not internally fixed to the inner sole; in the Remarks, Applicant defines what "internally fixed" means. In response to Applicant's argument, the examiner understands Applicant's explanation but is reading the phrase "internally fixed" more broadly. The examiner understands the limitation "internally fixed" to be met by the seam's (figure 2 part 4) penetrating into the internal structure of the shoe.

Applicant argues that Bartneck's inner sole is not pressed against the edge of the upper that is adjacent to the fillet. In response to Applicant's argument, the examiner sees that, at the bottom corners where all three of the inner sole, the upper and the fillet meet, the inner sole is pressed against the edge of the upper that is adjacent to the fillet.

Applicant argues that inverting the roles of Bartneck's upper piece and inner soles would yield something different from what Applicant is claiming. In response to Applicant's argument, the rejection is based on not on a mere inversion of parts without any other changes but on the view that Bartneck and Liebscher together provide the elements behind Applicant's claimed invention and a rationale for modifying them according to design choice.

Applicant argues that inverting Bartneck's upper and insole would make a different-looking shoe and therefore "change the principle of operation of Bartneck and render Bartneck unsuitable for its intended purpose." The examiner respectfully

disagrees. The change represents not a departure from Bartneck's principle of operation but an obvious variation. Regarding Bartneck's intended purpose, Bartneck writes that the object of the invention is "to provide a simplified method and apparatus for direct molding of an upper to a shoe sole" (col 2 In 13-16). The changes represented by Applicant's claims would nowise detract from Bartneck's meeting its goal.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magali P. Théodore whose telephone number is (571) 270-3960. The examiner can normally be reached on Monday through Friday 9:00 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Magali P. Théodore/
Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791